

1642



Patent
Attorney Docket No. 003300-920

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of
Thomas BRODIN et al.
Application No.: 10/088,639
Filing Date: March 20, 2002
Title: NOVEL COMPOUNDS

Group Art Unit: 1642
Examiner: Larry Ronald Helms
Confirmation No.: 7152

AMENDMENT/REPLY TRANSMITTAL LETTER

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Enclosed is a reply for the above-identified patent application.

- ☐ A Petition for Extension of Time is also enclosed.
- ☐ Terminal Disclaimer(s) and the ☐ \$55.00 (2814) ☐ \$110.00 (1814) fee per Disclaimer due under 37 C.F.R. § 1.20(d) are also enclosed.
- ☐ Also enclosed is/are _____

- ☐ Small entity status is hereby claimed.
- ☐ Applicant(s) requests continued examination under 37 C.F.R. § 1.114 and enclose the ☐ \$385.00 (2801) ☐ \$770.00 (1801) fee due under 37 C.F.R. § 1.17(e).
- ☐ Applicant(s) requests that any previously unentered after final amendments not be entered. Continued examination is requested based on the enclosed documents identified above.
- ☐ Applicant(s) previously submitted _____

_____ on _____
for which continued examination is requested.
- ☐ Applicant(s) requests suspension of action by the Office until at least _____, which does not exceed three months from the filing of this RCE, in accordance with 37 C.F.R. § 1.103(c). The required fee under 37 C.F.R. § 1.17(i) is enclosed.
- ☐ A Request for Entry and Consideration of Submission under 37 C.F.R. § 1.129(a) (1809/2809) is also enclosed.

- ☒ No additional claim fee is required.
- ☐ An additional claim fee is required, and is calculated as shown below.

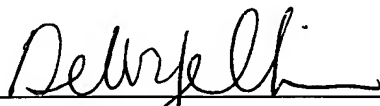
AMENDED CLAIMS					
	No. of Claims	Highest No. of Claims Previously Paid For	Extra Claims	Rate	Additional Fee
Total Claims		MINUS =	0	x \$18.00 (1202) =	\$ 0.00
Independent Claims		MINUS =	0	x \$86.00 (1201) =	\$ 0.00
If Amendment adds multiple dependent claims, add \$290.00 (1203)					
Total Claim Amendment Fee					\$ 0.00
<input type="checkbox"/> Small Entity Status claimed - subtract 50% of Total Claim Amendment Fee					\$ 0.00
TOTAL ADDITIONAL CLAIM FEE DUE FOR THIS AMENDMENT					\$ 0.00

- ☐ A check in the amount of _____ is enclosed for the fee due.
- ☐ Charge _____ to Deposit Account No. 02-4800.
- ☐ Charge _____ to credit card. Form PTO-2038 is attached.

The Director is hereby authorized to charge any appropriate fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(d) and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800. This paper is submitted in duplicate.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By 
 Deborah H. Yellin
 Registration No. 45,904

Date: May 6, 2004



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For: NOVEL COMPOUNDS)	

RESPONSE TO REQUIREMENT FOR RESTRICTION

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In complete response to the Official Action (Requirement For Restriction) mailed April 7, 2004, in regard to the subject application, Applicants elect Group I (claims 1-16, 34, and 37, drawn to antibody), with traverse.

37 C.F.R. § 1.475 and M.P.E.P. § 1893.03(d) indicate that when a group of inventions is claimed in a national stage application (filed under 35 U.S.C. § 371), as with the present invention, unity of invention is fulfilled when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. Thus, even if a group of inventions is claimed, a restriction for lack of unity should not be made unless the claims lack the same or corresponding special technical features.

Applicants submit that all of the claims share a corresponding technical feature, and thus should be rejoined for examination. Specifically, Group I is drawn

to an antibody, Group II is drawn to a target structure of alpha 6 beta 4, Group III is drawn to an organic chemical molecule that bind a target structure, Group IV is drawn to a peptide, Group V is drawn to an anti-id, Group VI is drawn to an organic molecule that blocks the function of the target structure, Group VII is drawn to a peptide that blocks the function of the target structure, Group VIII is drawn to a method of therapy for treating a condition based on anti-angiogenic mechanism by administration of an antibody, Group IX is drawn to a method of treating metastatic diseases by administering an antibody, Group X is drawn to a method of *in vitro* histopathological diagnosis by contacting the sample with an antibody, Group XI is drawn to a method of *in vitro* diagnosis of a target structure, Group XII is drawn to a method of *in vitro* determination of an antibody, Group XIII is drawn to a method of *in vitro* diagnosis of a target structure and an antibody, Group XIV is drawn to a method of *in vivo* diagnosis or imaging, Group XV is drawn to a method of treating malignant diseases by administering an antibody, Group XVI is drawn to a method of treating conditions by administering a target structure of alpha-6 beta-4, Group XVII is drawn to a method of treating conditions by administering an organic molecule, Group XVIII is drawn to a method of treating conditions by administration of a peptide, Group XIX is drawn to a method of assaying for an organic molecule and an antibody, and Group XX is drawn to a method of assaying for a peptide and an antibody.

Thus, Applicants submit that the claims should be rejoined, as all of the claims share the common technical feature of the antibody/antigen at issue. Specifically, the antibody defines the subject matter of the other Groups, as the antibody is required to define its antigen. For example, the organic molecule of Group III or the peptide of Group IV are defined in this way. The peptide, or organic chemical

molecule, which bind to either the antibody or the antigen, are defined by their reaction with the antibody.

The claims are directed to compounds, such as an antibody or target structure for same. A search of the art for an antibody, or its epitope, would overlap a search of its antigen or target structure. The claims, whether reciting compounds or methods of using the same, can all be searched together and searching them would not place a burden on the Examiner.

Finally, regardless of whether the cited Groups of claims are independent or distinct, Applicants respectfully assert that the Examiner need not have restricted the application. MPEP § 803 requires that "[i]f the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Therefore, it is not mandatory to make a restriction requirement in all situations where it would be deemed proper.

In the interest of economy, for the Office, for the public-at-large, and for Applicants, reconsideration and withdrawal of the restriction requirement are requested.

Response To Restriction Requirement

Application No. 10/088,639

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CONCLUSION

For at least those reasons set forth above, Applicants respectfully request withdrawal of the requirement for restriction and favorable consideration of all the claims of record on the merits. Should the Examiner have any questions regarding this application, he is invited to call the undersigned at the telephone number provided below.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

Date: May 6, 2004

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